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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID CARROLL CHALLENGER,
PETER ALEXANDER MANSON, and
DOUGLAS MORGAN TRENT

Appeal 2010-000997
Application 09/758,927
Technology Center 2400

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 2-45. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

The claims on appeal are directed to “a method and system for integrating a telephone function within an Internet appliance and, in particular[,] to integrating a telephone function with security and guidance features.” (Spec. 1). Claim 3, reproduced below, is representative of the claimed subject matter:

3. A method of integrating telephony function with security and guidance features on an Internet appliance comprising the steps of:

selecting a communication access number using a selection means, said communication access number operable to access a communication link via said Internet appliance;

alerting a user of said Internet appliance when an attempt is made to select said communication link via a dialing action of said Internet appliance using said communication access number;

receiving an authorization for said dialing action by said user of said Internet appliance; and

using a security protocol for encrypting and decrypting information transmitted on said communication link in response to authorizing said dialing action for said communication link.

REFERENCES

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Gullman	US 5,280,527	Jan. 18, 1994
Stewart	US 6,272,629 B1	Aug. 07, 2001
Voit	US 6,430,275 B1	Aug. 06, 2002
Rao	US 6,757,823 B1	June 29, 2004

REJECTIONS

1. Claims 3-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Voit and Rao. (Ans. 3-8).
2. Claims 14, 16-30, and 32-45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Voit and Stewart. (Ans. 8-20).
3. Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Voit, Rao, and Stewart. (Ans. 20-21).
4. Claims 15 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Voit, Stewart, and Gullman. (Ans. 21-23).

ANALYSIS

We address Appellants' contentions regarding the claims rejected under the four -stated rejections by proceeding seriatim from Rejection 1 through Rejection 4.

Rejection 1

Claims 3-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Voit and Rao.

Independent claim 3 and dependent claims 4, 11, and 12

Regarding the obviousness rejection of independent claim 3, Appellants contend, *inter alia*, that: “[t]here is no language in the cited passage [of Rao] that teaches using a security protocol for encrypting and decrypting information on a communication link in response to authorizing a dialing action for the communication link.” (App. Br. 6) (emphasis omitted).

Issue: Under § 103, did the Examiner err in finding that the cited references, either alone or in combination, would have taught or suggested the following disputed limitation:

using a security protocol for encrypting and decrypting information transmitted on said communication link in response to authorizing said dialing action for said communication link, within the meaning of independent claim 3?

In reviewing the record, we agree with the Examiner (Ans. 23-24) that Voit teaches authorizing a dialing action (col. 14, l. 40: “Internet Telephony Authorization”), and that Rao teaches “using a security protocol for encrypting and decrypting information transmitted on said communication link” within the meaning of claim 3. (See Rao col. 4, ll. 19-24: “H.323 gateways perform a 20 secure registration process in which they exchange information among themselves or with a translation server associated with the IP [i.e., Internet Protocol] network. The essence of the information exchanged includes encryption algorithms and public key Data.”). (See also Ans. 24). Thus, Appellants’ argument turns on whether the security protocol taught by Rao is used *in response to* the authorizing of the dialing information, as taught by Voit, which we conclude is a combinability argument.

Notwithstanding Appellants' arguments (*see also* Reply Br 2-3), our reviewing court guides that "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

This reasoning is applicable here, given that we find a security protocol would be desirable after the call (dialing action) is authorized to secure the communication. Thus, we are not persuaded of error regarding the Examiner's proffered rationale that "it would have been obvious to one of ordinary skill in the art to use the specific security features of Rao with the system of Voit to achieve a secure and encrypted communication line between two parties. This authentication would allow for not only the security of the communication lines against hackers, but also allows for the repudiation of the calling parties." (Ans. 4-5).

For these reasons, on this record, we sustain the Examiner's §103 rejection of independent claim 3 over the combination of Voit and Rao. Claims 4, 11, and 12 (not argued separately) fall with claim 3. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Dependent claims 5-7, 9, 10, and 13

Regarding the obviousness rejection of dependent claims 5-7, 9, 10, and 13 over the combination of Voit and Rao, we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2), the reasons set forth by the Examiner in the Answer in response to arguments made in Appellants' Appeal Brief. (*See* Ans. 24, *et*

seq.). Therefore, we sustain the Examiner's §103 rejection of dependent claims 5-7, 9, 10, and 13 over the combination of Voit and Rao.

Dependent claim 8

Responsive to Appellants' arguments regarding dependent claim 8 (App. Br. 9-10), we reverse the Examiner's rejection of claim 8 because the Examiner has not fully developed the record to show how the proffered combination of references teaches or suggests at least the claimed "built-in key escrow function" and the recited negative limitation of performing Voice-over IP (VOIP) services "between devices and a web page server lookup [that] may be performed in a DHCP [i.e., Dynamic Host Configuration Protocol] environment without side-channel communication for call or web reference look-up" (claim 8), as argued by Appellants (App. Br. 9-10). We agree with Appellants (App. Br. 9-10) that Voit's column 17, ll. 55-61 and Figure 1B, as relied on by the Examiner (Ans.7, 26), do not provide sufficient detail to fully support the rejection. *See* our reversal of dependent claims 25 and 41 *infra*, which recite commensurate limitations.

Rejection 2

Claims 14, 16-30, and 32-45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Voit and Stewart.

Independent claims 14 and 30

Regarding the obviousness rejection of independent claims 14 and 30, Appellants contend that the cited portions of Voit and Stewart do not teach or suggest "one or more personal identification means (PIM) input units coupled to a system bus in an ICA [i.e., Internet Client Appliance], said PIM input units operable to generate unique PIM signals," as recited in identical form in claims 14 and 30. (App. Br.13).

In particular, Appellants contend “[t]here is no language in the cited passages that teaches a personal identification means input unit in an Internet appliance. Neither is there any language in the cited passages that teaches a personal identification means input unit coupled to a system bus in an Internet appliance.” (App. Br. 13) (emphasis omitted).

Issue: Under § 103, did the Examiner err in finding that the cited references, either alone or in combination, would have taught or suggested the following disputed limitations (labeled L1-L3):

[L1] one or more personal identification means (PIM) input units coupled to a system bus in an ICA,¹ said PIM input units operable to generate unique PIM signals;

[L2] a security protocol circuit operable to encrypt, decrypt, store and retrieve said PIM signals and device driver code;

....

[L3] a dialing action controller (DAC) coupled to said system bus, and said Modems, said DAC operable receive a dialing action request and to alert a user of said dialing action and to enable or disable said dialing action to said Modems in response to said verification signal and a user signal[,]

within the meaning of independent claim 14 (footnote added), and the commensurate language of independent claim 30?

Limitation L1

When we look to Appellants’ Specification for *context*, we note that Appellants broadly describe “[an] Internet appliance [as] a device specialized for accessing e-mail and/or other data from the Web.” (Spec.

¹ See Appellants’ Specification, Fig. 1, step 102, depicting a dialing action that is requested from the Internet Client Appliance (ICA).

2:22-23). Thus, under a broad but reasonable construction, we construe the claimed ICA, or Internet Client Appliance (claims 14 and 30), as *any* client device that accesses data on the Internet. We are of the view that Voit's C2 object (that the Examiner finds teaches or suggests the claimed PIM, Ans. 29) is necessarily coupled to such a device bus, as required to effect the VOIP communication over the Internet. Moreover, Appellants acknowledge that "Voit teaches an object requiring a user ID and password to be provided prior to completing a voice over IP call." (App. Br. 14, ll. 4-5). We note that Voit describes the C2/C3 objects as follows:

C2: The Internet Telephony Call Control Object
C3: The Internet Telephony Authorization and Usage
Recording Object

(Voit, col. 8, ll. 52-54). According to at least one of the portions of Voit pointed to by the Examiner (Ans. 9), Voit teaches:

The C3 object is invoked during a call when an Authorization request is relayed over the interface C3.14. This interface is responsible for allowing an authorization of ITG [i.e., Internet Telephony Network] usage by a service subscriber, and for maintaining the current state of a subscriber's connections within C3, as well as passing ITG generated usage records from C2 to C3 in real time. Communication through the C3.14 interface is preferably *encrypted and secure*. The authorization request 45 relayed over C3.14 typically consists of an *account number and password provided by the PC User to be authenticated by C3*. At this point C3 checks the account password and available account balance. If the *password is correct* and the account remaining balance *permits the call to be established*, then C3 responds affirmatively to C2. C3 also retains data indicating that a call associated with that account is in progress. In such an architecture, *mutual authentication of C2 and C3*, and a secure transaction between them is preferred.

(Voit, col. 9, ll. 37-55) (emphasis added).

Voit teaches that “[t]he C2 object may require a *user ID and password* to be provided by the PC Client software prior to completing a V/IP call. This information is *authenticated* via the C3 object.” (Col. 13, ll. 29-32, emphasis added). Voit further teaches that “[t]he C3 object ensures coordination between User Authorization and Usage Recording for a single PC [i.e., Personal Computer] user's customer account” (col. 9, ll. 12-14), and that “[s]uccessful account *validation* by the C3 Object is a prerequisite to successful call establishment by the C2 Object.” (Col. 13, ll. 49-51, emphasis added). We particularly observe that Voit’s “FIG. 9 provides a high level diagrammatic illustration of a typical PC which may be utilized by a user in the system of the invention” (col. 7, ll. 30-32), and that Figure 9 *expressly depicts a PC system bus*. We also conclude that the claimed coupling does not preclude intermediate couplings.

Given these teachings and suggestions, we find at least Voit’s C2/C3 objects are coupled to the system bus contained within the “single PC,” which we find is an ICA within the meaning of independent claims 14 and 30. Therefore, on this record, we are not persuaded of Examiner error regarding limitation L1 of claims 14 and 30.

Limitation L2

Regarding disputed limitation [L2]: “a security protocol circuit operable to encrypt, decrypt, store and retrieve said PIM signals and device driver code” (claim 14), we agree with and adopt the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness, as articulated on pages 29-30 of the Answer:

The examiner contends that Voit teaches that the communications are preferably *encrypted and secure* (column 9 lines 44-45). The communication between two endpoints is

encrypted, and therefore, the decryption function is inherent in the endpoints, or else no communications could be understood. Furthermore, the argument that the cited prior arts do not teach retrieving a device driver code is not found persuasive. *Stewart was used to teach the limitation of using drivers in modems.*

Stewart states that "almost all modems in use at the present time are so-called "driver-based [] modems" (column 4 lines 14-20). Therefore, based on Stewart's teaching, at the time of invention, Voit would use a driver-based modem because that would be the predominant type of modem available to use in a network to "establish a network connection" (Stewart: Abstract). Therefore, the motivation to use such a modem is that it is the most common modem that would have been available at the time of invention.

(Ans. 29-30) (emphasis added).

Limitation L3

Regarding disputed limitation [L3]: "a dialing action controller (DAC) coupled to said system bus" (claim 14), we again note that at least Voit's PC (col. 13, l. 22) is expressly depicted with a system bus. (*See* Voit, Fig. 9: "Bus"). As noted above, we conclude that the claimed coupling does not preclude intermediate couplings. Therefore, we find the weight of the evidence supports the Examiner's underlying findings and ultimate legal conclusion of obviousness regarding disputed limitation L3:

The Examiner contends that the Voit teaches a dialing action controller that is operable to retrieve a dialing action request and to alert a user of the dialing action and to enable/disable the dialing action in response to a verification signal and a user signal. Voit teaches that the "C2 object is able to signal various states of a connection (ringing, busy, etc.) to a PC user" (column 13 lines 18-21), and further states that the "C2 object may require a user ID and a password prior to completing a V/IP call" (column 13 lines 26-29). This is interpreted as being the dialing action controller because the dialing is disabled if the authorization information is incorrect,

and enabled when the proper user name and password are received.
(Ans. 30).

We do not find Appellants' additional combinability arguments persuasive (App. Br. 19-21) because we find Appellants' claims simply arrange old elements with each performing the same function it had been known to perform and thus "yields no more than one would expect from such an arrangement." *See KSR*, 550 U.S. at 417 (citation omitted). We also agree with the Examiner that "Stewart is analogous art because it also deals with communication over a network with the use of modems, which is similar to the network communication methods of Voit." (Ans. 38).

For these reasons, we find the weight of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness. Accordingly, we sustain the Examiner's §103 rejection of independent claims 14 and 30 over the combination of Voit and Stewart.

Claims 20-23 and 27 (not argued separately) fall with claim 14.
Claims 36-39 and 43 (not argued separately) fall with claim 30. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Dependent claims 16-19, 24, 26, 28, 29, 32-35, 40, 42, 44 and 45

Regarding the obviousness rejection over the combination of Voit and Stewart of dependent claims 16-19, 24, 26, 28, 29, and associated paired commensurate claims 32-35, 40, 42, 44 and 45, we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons set forth by the Examiner in the Answer in response to arguments made in Appellants' Appeal Brief (Ans. 23 *et seq.*).

Therefore, we sustain the Examiner's §103 rejection of dependent claims 16-19, 24, 26, 28, 29, 32-35, 40, 42, 44 and 45 over the combination of Voit and Stewart.

However, we reverse the Examiner's rejection of dependent claims 25 and 41 for the same reasons discussed above regarding dependent claim 8, which recites commensurate limitations.

Rejection 3

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Voit, Rao, and Stewart.

Dependent claim 2

Regarding the obviousness rejection of dependent claim 2, Appellants contend that "Voit, Rao and Stewart, taken singly or in combination, do not teach or suggest 'prompting said user to enter a user personal identification means (PIM) in response to selecting said communication access number' as recited in claim 2." (App. Br. 30) (emphasis added). Appellants also contend that "Voit, Rao and Stewart, taken singly or in combination, do not teach or suggest 'initiating a pre-determined security protocol to retrieve a corresponding secure PIM for comparison' as recited in claim 2." (App. Br. 31). Appellants further contend that "Voit, Rao and Stewart, taken singly or in combination, do not teach or suggest 'retrieving secure device driver code for executing said dialing action using said security protocol in response to said authorization' as recited in claim 2." (App. Br. 31). Appellants further contend that "Voit, Rao and Stewart, taken singly or in combination, do not teach or suggest 'executing said dialing action using said device driver code for said communication link in response to said authorization and a user

response to said connectivity cost alert’ as recited in claim 2.” (App. Br. 32).

Issue: Under § 103, did the Examiner err in finding that the cited references, either alone or in combination, would have taught or suggested the following disputed limitations (labeled L1-L4):

[L1] prompting said user to enter a user personal identification means (PIM) in response to selecting said communication access number;

[L2] initiating a pre-determined security protocol to retrieve a corresponding secure PIM for comparison;

....

[L3] retrieving secure device driver code for executing said dialing action using said security protocol in response to said authorization;

....

[L4] executing said dialing action using said device driver code for said communication link in response to said authorization and a user response to said connectivity cost alert[.]

within the meaning of dependent claim 2?

In reviewing the record, we agree with the Examiner (Ans. 36-37) that the first two disputed limitations of claim 2 [L1-L2] are taught or suggested by Voit (col. 13, ll. 39-42). The Examiner finds Voit teaches an authorization request as “being the same as prompting a user to enter the personal identification means as it is being requested of the user to enter a password and account number.” (Ans. 36; *see also* 37; *see also* Voit, col. 5, ll. 6, 52, 54; col. 6, l. 8; col. 9, l. 48; col. 10, l. 2; col. 13, l. 6, 19). We observe that Voit teaches “[t]he C2 object may require a *user ID and password* to be provided by the PC Client software prior to completing a V/IP call. This information is *authenticated* via the C3 object.” (Voit, col. 13, ll. 29-32, *emphasis added*).

Because we find any password authentication system necessarily requires comparing the entered password with a stored password (i.e., retrieve *a corresponding secure PIM* for comparison), we agree that the proffered combination teaches or suggests both limitations L1 and L2. See Voit: “*If the password is correct and the account remaining balance permits the call to be established, then C3 responds affirmatively to C2.*” (Col. 9, ll. 49-50).

Regarding disputed limitations L3 and L4, we note that the Examiner relies on Stewart as teaching or suggesting the device driver code limitation (Ans. 37). The security and authorization and dialing actions are taught or suggested by Voit and Rao, as previously discussed above. We note that the Examiner’s rejection is based on the *combined* teachings and suggestions of Voit, Rao, and Stewart.

We do not find Appellants’ additional combinability arguments persuasive (App. Br. 33-36) because we find Appellants’ claims simply arrange old elements with each performing the same function it had been known to perform and thus “yield[] no more than one would expect from such an arrangement.” *See KSR*, 550 U.S. at 417 (citation omitted). As previously discussed, we agree with the Examiner that “Stewart is analogous art because it also deals with communication over a network with the use of modems, which is similar to the network communication methods of Voit.” (Ans. 38).

Therefore, on this record, we are not persuaded of Examiner error. Accordingly, we the sustain obviousness rejection of dependent claim 2 over the combination of Voit, Rao, and Stewart.

Rejection 4

Claims 15 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Voit, Stewart, and Gullman.

Dependent claims 15 and 31

Based on Appellants' arguments, we will decide the appeal of the rejection of dependent claims 15 and 31 on the basis of representative claim 15. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Regarding the obviousness rejection of claims 15 and 31, Appellants contend, *inter alia*, that:

Appellants respectfully traverse that Voit, Stewart and Gullman, taken together, teach *a smart card reader*. Appellants performed a search of the phrase "smart card reader" in Voit, Stewart and Gullman and were unable to identify the phrase "smart card reader" or any variation thereof. The Examiner cites the Abstract of Gullman as teaching "an integrated circuit card" and concludes that Gullman teaches a smart card reader. The Examiner must provide a basis in fact and/or technical reasoning to conclude that the teaching of an integrated circuit card in Gullman is equivalent to a smart card reader.

(App. Br. 36-37) (emphasis added).

The Examiner disagrees:

The Examiner contends that the Voit and Gullman references in combination do teach a smart card reader. Gullman states that an IC card [is used for] storing biometric information, and [is] used for the purpose of accessing secure areas (column 5 lines 34-39). Furthermore, in this embodiment, there is a scanning device (smart card reader) which can read biometric data from the card (column 5 lines 49-54). Therefore, it is interpreted that this sensor is a smart card reader.

(Ans. 39).

We agree with the Examiner that card 14 (Gullman, Fig. 3) falls within the broad scope of the claimed "smart card," according to the plain

meaning of the term. Because Gullman describes sensor 18 (located on card 14, Fig. 3) as a “scanning device” (for detecting a fingerprint, col. 5, l. 50), we find it is a smart card reader (i.e., a reader or scanning device on a smart card). Nor do we find Appellants’ additional combinability arguments persuasive (App. Br. 37), because we find Appellants’ claims 15 and 31 simply arrange old elements with each performing the same function it had been known to perform and thus “yield[] no more than one would expect from such an arrangement.” *See KSR*, 550 U.S. at 417 (citation omitted).

For these reasons, we sustain the Examiner’s rejection of claims 15 and 31 (which recite the identical “smart card reader” limitation disputed by Appellants).

DECISION

We reverse the Examiner’s obviousness rejections of claims 8, 25, and 41 under § 103.

We affirm the Examiner’s obviousness rejections of claims 2-7, 9-24, 26-40, and 42-45 under § 103.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

ORDER

AFFIRMED-IN-PART

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